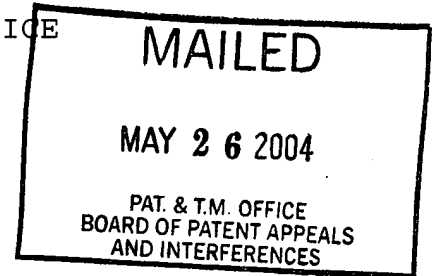


The opinion in support of the decision being entered today is not binding precedent of the board

Paper 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte CHRISTOPHER A. SCHANTZ, KYLE J. SCHLEIFER,
WILLIAM D. FISHER, MICHAEL P. CAREN and PETER G. WEBB

Appeal 2003-1673
Application 09/558,532¹

Before: WINTERS and WILLIAM F. SMITH, Administrative Patent Judges, and McKELVEY, Senior Administrative Patent Judge.

McKELVEY, Senior Administrative Patent Judge.

**Request for Applicants to Address Matters
37 CFR § 1.196(d)**

The appeal is from a decision of a primary examiner rejecting claims 4-7, 9-11, 13-17, 21, 28-32, 38 and 43-44, all the claims remaining in the application on appeal. Because we feel that we need additional information to enter a reasoned decision, we request that applicants address certain matters.
37 CFR § 1.196(d) (2003) ["Rule 196(d)"].

¹ Application for patent filed 26 April 2000. The real party in interest is Agilent Technologies, Inc. (Brief, Paper 14, page 2).

A. Matters associated with the drawings

We have reviewed the specification and the drawings. Certain matters remain unclear to us following that review. Applicants are therefore requested to address the following matters related to the specification and drawings.

1. We have not been able to locate any discussion in the specification with respect to drawing element 18 which appears in Fig. 4.

- a. We would appreciate applicants calling our attention to that portion (page and line) of the specification which discusses element 18.
- b. We would also appreciate an electronic version of the specification on (1) a floppy disk or (2) as an attachment to an e-mail directed to sonja.desperrtt@uspto.gov.

2. We have not been able to locate any discussion in the specification with respect to drawing element 170 which appears in Fig. 4. We would appreciate applicants calling our attention to that portion of the specification which discusses element 170. There is a possibility that applicants meant for element 170 to be element 214, a matter on which applicants are free to comment. Element 214 is discussed in the specification (page 14, line 22), but we have not been able to find element 214 in the drawings.

3. We have not been able to locate any discussion in the specification with respect to drawing element 14b which

appears in Fig. 4. We would appreciate applicants calling our attention to that portion of the specification which discusses element **14b**.

4. In Fig. 5, there is an "element" below element **184**, and between element **160** and an arrow pointing to the left, which has no drawing number. Should the "element" have a drawing number? Where is the "element" discussed in the specification?

5. Should element **214h** in Fig. 6C be labeled as element **214j**? See specification, page 15, line 3. Also, should the language "sensing element **214d**" on page 15, line 3 of the specification read "sensing element **214j**"?

6. Should the language "Opening **214**" on page 14, line 25 of the specification read "Opening **214b**"?

7. We have not been able to find in the drawings any reference to elements **186** or **320** notwithstanding that both elements are mentioned on page 15, lines 27-28 and page 16, line 11 of the specification. We would appreciate applicants pointing out where both elements appear in the drawings. We believe there may be some possibility that the reference to element **186** in the specification is in fact a reference to element **326** of the drawings. See Fig. 4.

8. The specification makes reference to "sensing element **214**" (e.g., page 16, line 21). While we have found references to elements **214a** through **214h** in Figs. 6A, 6B and 6C, we have not found in these Figs. a reference to element **214** per se. We would appreciate applicants helping us out in this

respect. Perhaps, applicants' reference to 214 in the specification is a general reference to the three embodiments shown in Figs. 6A, 6B and 6C.

9. We have not been able to find in the drawings a reference to element 190. The element is discussed on page 21, line 30 of the specification. We would appreciate applicants' pointing out where element 190 appears in the drawing.

B. Documents incorporated by reference into the specification

Numerous documents are mentioned in the specification. We request that applicants supply a copy of each of the following documents:

1. Caruthers (page 2, line 17);
2. Itakura (page 2, line 17);
3. Hunkapillar (page 2, line 18);²
4. Southern (page 2, line 26);
5. Relevant portions of application 09/150,507 (page 13, line 8);
6. Relevant portions of application 08/946,190 (Page 19, line 1); and
7. Relevant portions of application 09/359,527 (page 19, line 27).

² It is noted that a reference is made to "pages 100 et seq." In complying with this requirement, applicants may submit copies of the pages intended to be covered by "et seq."

Applicants should also comment on which portion (page and line and/or figure) of each document is believed to be the most relevant to any incorporation by reference.

C. Reading claims onto the drawings

In interferences cases before the Trial Section, the parties are required to file a separate paper containing a copy of the claims in which following each element recited in each claim, the drawing numbers corresponding to that element are inserted in bold in braces, e.g., { }. It would be helpful to the panel in understanding the claims before us if applicants did the same in this particular ex parte case with respect to each claim in issue.

At the request of Paralegal Specialist Sonja Despertt, counsel for applicants sent an e-mail with an attachment comprising a copy of the brief (including the claims). Claim 4, as an example, has been copied from the attachment and is set out below with "empty" brackets (in place of braces). We would appreciate applicants filling in (1) the drawing element and (2) the most relevant reference to the specification in each empty set of brackets. Cf. Ex parte Braeken, 54 USPQ2d 1110, 1112-1113 (Bd. Pat. App. & Int. 1999) (example of how an examiner should read a claim onto a reference). Applicants should reproduce the remaining claims which they wish to have considered and insert appropriate brackets and information within those brackets consistent. We recognize that there may be some instances (such as where there is no drawing element of a feature described in

the specification) where it may be appropriate to refer only to the specification, particularly with respect to method claims.

Claim 4: A method of fabricating at least one addressable array [] of biopolymers [] with multiple features [] on a substrate [] using a drop deposition apparatus [] having a drop dispenser unit [] and a sensing element [], comprising:

(a) for each of multiple addresses [], dispensing droplets [] carrying the biopolymers [] or biopolymer precursors [] from a drop dispenser unit [] onto the sensing element [], and onto the substrate [] so as to fabricate the array [];

(b) detecting electrical signals [] resulting from dispensed droplets striking the sensing element [];

(c) evaluating a performance characteristic [] of the deposition apparatus [] based on the detected signals [] wherein the sensing element [] optionally [] comprises the substrate [];

additionally comprising:

when after the dispensing of some droplets onto the substrate an error [] is detected [] in which an evaluated performance characteristic [] is outside a predetermined tolerance [], then the source [] of the error is corrected [] prior to dispensing [] of other of the droplets [] onto that same substrate [] or the deposition apparatus is operated [] so as to compensate

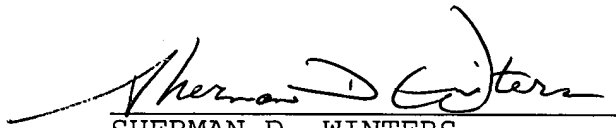
for the error [] during dispensing of other of the
droplets [] onto that same substrate [].

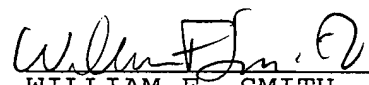
D. Time for taking action

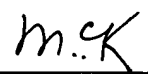
Applicants are given a non-extendable time period of **three (3) months** from the date of this Request within which to answer the Request. 37 CFR § 1.196(d) (2003). Any response should be hand-delivered to the Board or addressed to:

Mail Stop Interference
Board of Patent Appeals and Interferences
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, Virginia 22313-1450

Failure to timely respond to this Request may result in dismissal of the appeal.



SHERMAN D. WINTERS
Administrative Patent Judge)
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WILLIAM F. SMITH
Administrative Patent Judge)
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FRED E. MCKELVEY, Senior
Administrative Patent Judge)

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022878

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Loveland, CO 80537-0599

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